

## Remarks

### **I. STATUS OF THE CLAIMS**

Claims 10-30 are pending.

Claim 14 is objected to.

Claims 10-13, 15-30 are rejected under 35 U.S.C. §102(e).

Claim 10 is the sole independent claim.

### **II. AMENDMENTS**

Claim 14 is canceled as it depended from a previously withdrawn claim.

### **III. REJECTION OF CLAIMS UNDER 35 U S C §102(e)**

Claims 10-13, 15-30 are rejected under 35 U.S.C. §102(e) as being anticipated by Ruiz US 6,129,722. In support of the rejection the examiner states that *Ruiz discloses apparatus and methods for correcting higher order aberrations of a patient's eye, the methods comprising the steps of inflicting a required surgical trauma to the eye corresponding to a particular ophthalmological procedure; obtaining diagnostic wavefront information subsequent to inflicting the trauma; and developing a treatment profile for correcting said higher order aberrations as presently claimed.* Applicant respectfully traverses this rejection as being improper.

According to MPEP §2131, “[A] claim is anticipated only if each and every element as set forth in the claim is found, either expressly, or inherently described in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the ...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Applicant respectfully submits that Ruiz ‘722 discloses neither *a method for correcting higher order aberrations of a patient's eye; inflicting a required surgical trauma to the eye corresponding to a particular ophthalmological procedure; obtaining diagnostic wavefront information subsequent to inflicting the trauma; nor developing a*

*treatment for correcting the higher order aberrations of the patient's eye at least in part upon the subsequent wavefront* information, as required by claim 10 and claims 11-13 and 15-30 depending therefrom.

The examiner has failed to point out where any of the claim elements are described in the reference, where the details of the identical invention are described in the reference, and where the required arrangement of the elements are set out in the reference. Moreover, a word search of the 22 columns of text and the 52 claims of the '722 patent quickly confirms that the words/phrases *higher order aberration*, *surgical trauma* and *wavefront* do not appear anywhere in the patent.

A careful reading of '722 reveals that topography diagnostics are used to determine corneal irregularities for the correction of myopia and hyperopia with or without astigmatism, which are well known to be lower order aberrations only. All of the ablation procedures contemplated in '722 are fit to a reference sphere. Even the aspherical option discussed in '722 is limited to producing myopic and hyperopic corrections.

Applicant submits that the examiner has not met his burden of establishing a lack of novelty of the pending claims and, therefore, the rejection is improper. Applicant respectfully requests reconsideration of the application and timely allowance of the claims.

Date: April 15, 2004

Respectfully submitted,

WALL MARJAMA & BILINSKI

By: William Greener

William Greener

Registration No. 38,165

101 S. Salina St., Suite 400

Syracuse, NY 13202

(607) 256-8338

Customer No.: \*20874\*

20874

PATENT TRADEMARK OFFICE